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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,630	11/10/2003	Kazumasa Nagafuchi	F-8025	4803

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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT PAPER NUMBER

1772

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/705,630	<b>Applicant(s)</b> NAGAFUCHI, KAZUMASA	
	<b>Examiner</b> Patricia L. Nordmeyer	<b>Art Unit</b> 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 1 – 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “a label sheet having a layer of adhesives coated on the back surface of a sheet of paper and releasing sheet having a layer clay coated on the surface of a sheet” in claim 1 is unclear, which renders the claim vague and indefinite. Based upon the specification, it appears that the label sheet is connected to the releasing sheet by the layer of adhesives; however, there is no support in the claim language showing this connection between the sheets. Is the releasing sheet supposed to be a separate invention from the label sheet with the layer of adhesives?

The phrase “a layer of clay coated on the surface of a sheet of paper” in claim 1 is unclear, which renders the claim vague and indefinite. It is unclear from the claim language which surface of the sheet of paper is coated with the layer of clay. Does it have to be layer that is possibly in contact with the adhesives, or could it be the opposite surface of the paper?

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The phrase “a label sheet having a layer of adhesives coated on the back surface of a sheet of paper and releasing sheet having a layer clay coated on the back surface of a sheet” in claim 2 is unclear, which renders the claim vague and indefinite. Based upon the specification, it appears that the label sheet is connected to the releasing sheet by the layer of adhesives; however, there is no support in the claim language showing this connection between the sheets. Is the releasing sheet supposed to be a separate invention from the label sheet with the layer of adhesives?

The phrase “said layer of clay further coated with a layer of releasing agents” in claim 2 is unclear, which renders the claim vague and indefinite. It is unclear from the claim language which layer clay is coated with the layer of releasing agents, the back surface or front surface. Or is the both of the surfaces coated with the releasing agents?

The phrase “a sheet of paper having the water absorbing capacity of cob of less than  $30 \text{ g/m}^2$ ” in claim 3 is unclear, which renders the claim vague and indefinite. It is unclear from both the specification, as if refers to another Japanese application, and the claim language what is meant by the above phrase. What is “cob”? How is a measure of absorbing? What kind of paper meets these limitations? Is there something special about the paper or the treatment to the paper?

The phrase “a label sheet made of a polyester synthetic resin film....and a releasing sheet made of a sheet of paper” in claim 4 is unclear, which renders the claim vague and indefinite. Based upon the specification, it appears that the label sheet is

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connected to the releasing sheet by the layer of adhesives; however, there is no support in the claim language showing this connection between the sheets. Is the releasing sheet supposed to be a separate invention from the label sheet with the layer of adhesives?

The phrase “a label sheet made of a polyester synthetic resin film....and a releasing sheet made of a sheet of paper” in claim 5 is unclear, which renders the claim vague and indefinite. Based upon the specification, it appears that the label sheet is connected to the releasing sheet by the layer of adhesives; however, there is no support in the claim language showing this connection between the sheets. Is the releasing sheet supposed to be a separate invention from the label sheet with the layer of adhesives?

The phrase “the label sheet may be prevented from being broken easily at a gap” in claim 6. It is unclear from the claim language where the gap is present. Is the gap formed when the labels are cut into the label sheet? Is there a gap between the label sheet and the release sheet? Why is it a problem if the label sheet is broken at a gap?

Correction/clarification is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant

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for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Iwabuchi et al. (USPN 6,703,121).

Iwabuchi et al. disclose a sheet of affixing labels (Column 1, lines 6 – 7) comprising a label sheet having a layer of adhesives (Column 2, lines 22 – 27) coated on the back surface of a sheet of paper (Column 4, lines 48 – 52) and a releasing sheet having a layer of clay coated either on the surface of a sheet of paper or both the front and back surface of a sheet of paper (Column 4, lines 58 – 61), said layer of clay being further coated with a layer of releasing agents (Column 4, line 66 to Column 5, line2) as in claims 1 and 2.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 – 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwabuchi et al. (USPN 6,703,121).

Iwabuchi et al. disclose a sheet of affixing labels (Column 1, lines 6 – 7)

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comprising a label sheet having a layer of adhesives (Column 2, lines 22 – 27) coated on the back surface of a sheet of paper (Column 4, lines 48 – 52) and a releasing sheet having a layer of clay coated either on the surface of a sheet of paper or both the front and back surface of a sheet of paper (Column 4, lines 58 – 61), said layer of clay being further coated with a layer of releasing agents (Column 4, line 66 to Column 5, line 2). As in claims 4 and 5, the label sheet may also be made from a polyester synthetic film (Column 4, lines 48 – 52).

With regard to a sheet of paper having the water absorbing capacity of cob of less than  $30 \text{ g/m}^2$ , a front surface covered with a layer of matting agents including anti-static agents and fine particle and the label sheet being prepared so as to be 15 g/m to 35 g/m heavier than the releasing sheet in claims 3 – 6, one of ordinary skill in the art would expect that compositions that overlap would have overlapping properties, since Iwabuchi et al. teaches the use of the label sheet with precision electronics (Column 1, lines 7 – 12) and that the thickness of the label sheet may vary in thickness (Column 4, lines 54 – 57).

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 4,758,456 to Muscala and U.S. Patent No. 5,851,662 to Suzuki et al. are cited to show the state of the art with regard to label sheets having release liners coated with clay and releasing agents.

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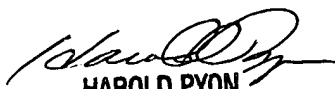
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia L. Nordmeyer  
Examiner  
Art Unit 1772

  
pln

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER

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5/27/05